Hearing:
June 6, 2000
rls/em

Paper No. 15

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11/30/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re N.A.D., Inc. also trading as North American Drager

Serial No. 75/370,139

Stanley H. Cohen of Caesar Revise Bernstein Cohen & Pokotilow, LTD. for N.A.D., Inc.

Wendy Goodman, Trademark Examining Attorney, Law Office 103 (Michael Szoke, Managing Attorney).

Before Simms, Cissel and Hanak, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

N.A.D., Inc., also doing business as North American Drager (applicant), a Pennsylvania corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark SATURN INFORMATION SYSTEM ("INFORMATION SYSTEM" disclaimed) for computer software that assists anesthesiology in the recording and reporting of anesthesia related data.[1] The

[1] Application Serial No. 75/370,139, filed October 8, 1997, based upon applicant's allegation of a bona fide intention to use the mark in commerce.

Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), citing two registrations held by Saturn Systems, Inc. Those registrations cover the mark SATURN for prerecorded computer programs recorded on tape, cards or disks,[2] and the mark shown below

for prerecorded computer programs recorded on tapes, disks or diskettes; computer hardware, namely, minicomputers, microcomputers and parts thereof.[3] The Examining Attorney contends that applicant's mark so resembles the registered marks that, when applicant's mark is used, there would be a likelihood of confusion. Briefs have been filed and an oral hearing was held.

We affirm.

The Examining Attorney argues that the term "SATURN" is the most prominent part of applicant's mark, the remaining words in applicant's mark being descriptive and disclaimed, and that this dominant feature of applicant's mark is identical to one of registrant's marks and is nearly identical to the other. The

[2] Registration No. 1,203,413, issued August 3, 1982, Sections 8 and 15 affidavit filed.

Examining Attorney notes that one feature of a mark may be more significant in creating a commercial impression and may, therefore, be given greater weight. With respect to the goods, the Examining Attorney notes that the computer programs listed in registrant's registrations are unlimited as to the field of use and that, therefore, we must assume that registrant's goods may encompass all computer programs and that they would travel in similar channels of trade as applicant's goods to all classes of potential purchasers. According to the Examining Attorney, registrant's goods, being unlimited as to kind or field of use, could include applicant's specific type of computer software. The Examining Attorney asks that we resolve any doubt in favor of the registrant.

Applicant, on the other hand, argues that the marks are distinctly different and readily distinguishable both visually and aurally. Applicant also contends that the term SATURN is widely registered and, therefore, not a distinctive mark. Noting that registrant's registrations issued before the Office changed its policy concerning the identification of computer software,[4] applicant maintains that its software is intended for a specific field of medicine, namely, anesthesiology, that its software is expensive (over $6,000) and that knowledgeable,

[3] Registration No. 1,287,729, issued July 13, 1984, Sections 8 and 15 affidavit filed.

sophisticated purchasers (trained medical personnel) use applicant's software in hospitals. The file contains a declaration of applicant's product manager describing the nature of applicant's computer software.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood-of-confusion issue. In re E. I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In

any likelihood-of-confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1996).

While applicant's mark and registrant's marks are not identical, applicant's mark SATURN INFORMATION SYSTEM has obvious similarities in sound and appearance to registrant's marks SATURN and SATURN and design. As the Examining Attorney has noted, the words "INFORMATION SYSTEM" are descriptive and have been disclaimed by applicant.[5] These descriptive, if not generic, words have little or no source-indicating significance. If applicant's and registrant's marks were used on commercially related products, confusion may be likely. We believe that

[4] See TMEP §804.03(b) for current Office policy.

these marks are so similar that even sophisticated purchasers may well believe that the software comes from the same source.

We turn, then, to a consideration of the respective goods. As the Examining Attorney has noted, the question of likelihood of confusion must be determined on the basis of the goods set forth in applicant's application and those in the cited registrations, rather than on what any evidence may show those goods to be. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Registrant's goods are broadly identified as computer programs recorded on tapes or disks, without any limitation as to the kind of programs or the field of use. Accordingly, we must assume that registrant's goods encompass all such computer programs including those which may be intended for the medical field. As such, they may travel in the same channels of trade normal for those goods and to all classes of prospective purchasers for those goods. In re Linkvest S.A., 24 USPQ2d 1716 (TTAB 1992) and cases cited therein. When the goods are so viewed, we believe that confusion is likely. Purchasers, even sophisticated purchasers, aware of registrant's SATURN software (presumed to be in the same field), who then encounter

[5] Evidence of the descriptive, if not generic, nature of the terms "information system" is attached to the final refusal.

applicant's SATURN INFORMATION SYSTEM software are likely to believe that these goods come from the same source.

While we are sympathetic to applicant's concern about the scope of protection being given to the cited registrations, applicant is not without remedies in its attempt to obtain a registration. Applicant may, of course, seek a consent from the owner of the cited registrations, or applicant may seek a restriction under Section 18 of the Trademark Act, 15 USC §1068. This remedy is available for those who believe that a restriction in the cited registration(s) may serve to avoid a likelihood of confusion. See Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, 34 USPQ2d 1266 (TTAB 1994). Compare Electronic Data Systems Corp. v, EDSA Micro Corp., 23 USPQ2d 1460 (TTAB 1992)(no likelihood of confusion between specifically identified computer services and programs in different fields--computer data processing programming/information management services and computer programs for electrical distribution system analysis and design).[6]

[6] In the *Linkvest* case, we held that registrant's broadly identified computer programs encompass all such computer programs including the more specific computer programs of applicant. We also stated in that case that we must therefore assume that the goods of applicant and registrant will travel in the same channels of trade to the same class of purchasers. Moreover, as noted above, the question of likelihood of confusion must be determined based on an analysis of the goods identified in applicant's application vis-à-vis the goods identified in the registration, rather than what the evidence shows the goods actually are. Canadian Imperial Bank v. Wells Fargo Bank, *supra*, and Octocom Systems, Inc. v. Houston Computer Services, Inc., 918 F.2d

Decision: The refusal of registration is affirmed.

R. L. Simms

R. F. Cissel
Administrative Trademark
Judges, Trademark Trial
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937, 16 USPQ2d 1783 (Fed. Cir. 1992). It is not at all clear to us that applicant's goods are "inherently" very expensive and purchased after significant discussion and negotiation between the manufacturer and its customers. To the extent the dissent's conclusion of no likelihood of confusion rests on extrinsic evidence of what applicant's goods actually are rather than on how they are described in the application, we believe it to be improper.

Hanak, Administrative Trademark Judge, Dissenting:

I respectfully dissent. While acknowledging that "applicant's mark and registrant's marks are not identical," the majority goes on to state that the words INFORMATION SYSTEM in applicant's mark are descriptive and thus "have little or no source-indicating significance." (Majority opinion page 4).

I believe that the majority's analysis is contrary to the teachings of our primary reviewing Court. It is clear that "marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight." In re Hearst Corp., 982 F.2d 493, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992). (The Court found that there was no likelihood of confusion resulting from the contemporaneous use of VARGAS and VARGA GIRL on identical, inexpensive consumer goods despite the Board's view that the word "girl" was merely descriptive of the goods.). Indeed, our primary reviewing Court has specifically said that portions of marks, "even if descriptive, cannot be ignored." In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986).

With these guiding principles in mind, I am of the view that applicant's three word mark SATURN INFORMATION SYSTEM is obviously different from registrant's one word mark SATURN and registrant's one word mark SATURN and design. The differences in visual appearance and pronunciation are clear. Moreover, the

presence of the words INFORMATION SYSTEM in applicant's mark, even assuming these words are descriptive, causes applicant's mark to have different connotative properties than registrant's mark SATURN or registrant's mark SATURN and design.

Given the fact that there are obvious differences in the marks, I turn to a consideration of the goods of applicant and registrant. Registrant's goods are very broadly described as prerecorded computer programs. This extremely broad description of goods may encompass applicant's very specific "computer software that assists anesthesiology in the recording and reporting of anesthesia related data." However, applicant has made a very strong showing that the computer software as described in its application is very expensive; is purchased only by very sophisticated individuals; and is purchased only after a significant amount of discussion and negotiation between a manufacturer and its customers.[7]

Considering first the cost of anesthesiology computer software, applicant has established that such highly specialized computer software is inherently very expensive. Obviously, "confusion is less likely where goods are expensive." Magnaflux

[7] With regard to footnote 6 in the majority opinion, it should be made clear that my analysis is based on the goods as described in the application, and not on applicant's actual goods. In this respect, the Examining Attorney has never disputed applicant's contention that anesthesiology computer software in general is inherently very expensive; is purchased only by very sophisticated individuals; and is

Corp. v. Sonoflux Corp., 231 F.2d 669, 109 USPQ 313, 315 (CCPA 1956). See also Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840, 1841 (Fed. Cir. 1990).

In addition, applicant has also clearly demonstrated that anesthesiology computer software is only purchased by very sophisticated individuals and that anesthesiologists have the largest say in making the purchasing decision. It has been held that physicians are "a highly intelligent and discriminating public." Warner-Hudnut, Inc. v. Wander Co., 280 F.2d 435, 126 USPQ 411, 412 (CCPA 1960). Moreover, our primary reviewing Court has made it clear that purchaser "sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." Electronic Design & Sales v. Electronic Data Systems, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992).

Finally, in addition to establishing that anesthesiology computer software is inherently very expensive and is purchased only by sophisticated individuals, applicant has also established that such computer software is not something that can be purchased in a store, but instead must be purchased by dealing and negotiating with the manufacturer of such equipment. In other words, anesthesiology computer software is purchased

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purchased only after significant interaction between buyer and seller. See Examining Attorney's brief page 5.

"after careful consideration," and this is yet another factor in reducing the likelihood of confusion. Electronic Design & Sales, 21 USPQ2d at 1392.

In short, I would find that given the fact that anesthesiology computer software is inherently very expensive; is purchased only by very sophisticated individuals; and is purchased only after direct negotiations with the manufacturer, that under these circumstances, sophisticated purchasers would be
able to distinguish between the marks SATURN INFORMATION SYSTEM, on the one hand, and SATURN and SATURN and design, on the other hand.

E. W. Hanak
Administrative Trademark
Judge, Trademark Trial
and Appeal Board